

REMARKS

These remarks are responsive to the Final Office Action dated April 28, 2004. In that Office Action, claims 1-18 were examined, claims 1-5, 7-16 and 18 were rejected under 35 U.S.C. 102(e) and claims 6 and 17 were rejected under 35 U.S.C. 103(a). Reconsideration of the application is respectfully requested in light of the following amendments and remarks.

Telephone Interview on June 8, 2004

Applicants wish to thank the Examiner for the consideration extended to Applicants' representative during the telephone interview conducted on June 8, 2004, during which Applicants' representative and Examiners Nguyen and Amsbury discussed claims 12-14 with respect to the prior art. While no agreement was reached as to the merits of the case, it is believed that all involved came away with a better understanding of the present invention, the prior art and the examination process. At the Examiner's suggestion, Applicants herein amend claims 13 and 14 into independent form to make it easier for the Examiner to review the claims again.

Claim Amendments

Please cancel claims 1-11 and claims 15-18 without prejudice. Applicants reserve the right to pursue the subject matter of these claims in future continuing applications.

Please amend claims 13 and 14 to be rewritten in independent form as suggested by the Examiner to facilitate the Examiner's review of this case. Applicants submit that this amendment does not change the scope of claims 12-14, only their form. To the extent that this is beneficial to the Examiner in review after a Final Office Action, Applicants see no reason not to assist the Examiner in this way.

Claim Rejection under 35 U.S.C. 102(e)

The Examiner rejected claim 1-5, 7-16 and 18 were rejected under 35 U.S.C. 102(e) in view of Van Huben et al., U.S. Pat. No. 5,590,201 (hereinafter "Van Huben"). Applicants herein cancel claims 1-11 and 15-18, therefore the rejections of those claims are mooted until the Applicants file a continuing application to pursue that subject matter. With respect to claims 12-

14, Applicants respectfully traverse this rejection and ask the Examiner to consider the following arguments.

Under 35 U.S.C. § 102, a reference must show or describe each and every element claimed in order to anticipate the claims. *Verdegaal Bros. v. Union Oil Co. of California* 814 F.2d 628 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). Applicants believe that the Examiner has failed to show each and every element of claims 12-14 as required.

Regarding the First Element of Claim 12

The Examiner rejected the first element of claim 12 "receiving a notification that a new resource has been installed on the network environment" in which the Examiner provides only a citation to Col. 31, lines 18-38 of Van Huben and absolutely no discussion as to what in the citation provides the grounds for the rejection. The citation includes a discussion of providing notifications to users that user-initiated actions (referred to in Van Huben as "tasks") have been performed. The nature and purpose of this notification is clearly stated in Col. 31, lines 36-38 ("Successful operations also result in notification thus ensuring users possess situational awareness of their data at all times." emphasis added). This is distinctly different from the claimed element for at least two reasons. First, as the claim is a claim to a computer-implemented method, the claimed element is a notification to the computer, not to the user, that computer resource has been added to the network. Furthermore, Applicants' notification is not in response to a task initiated by the user, but rather in response to the installation of the new resource. Therefore, Applicants believe that the Examiner has failed to show this element of the claimed invention.

Regarding the Second Element of Claim 12

The Examiner rejected the second element of claim 12 "retrieving search information associated the data and tasks of the new resource" in which the Examiner provides only a citation to Col. 31, lines 18-38 of Van Huben and absolutely no discussion as to what in the citation provides the grounds for the rejection. Applicants' submit that Col. 31, lines 18-38 of Van

Huben relate only to a distributed library file system, and not to installing resources on a network environment.

An examination of the citation reveals as relevant only the sentence: “The Library Manager incorporates routines for properly installing any output created by an Automated Library Process into the [Data Management System].” Van Huben indicates that the “output” referred to here is purely a library data file in Col. 60, line 28 (“Note: [Automated Library Machines] only deal with file manipulation requests.”), and not a file in any way related to “tasks of the new resource” as claimed. Van Huben’s “output” also does not have any relationship to resources of the computing network other than being stored on some resource of the network. Furthermore, Van Huben’s “output” is not retrieved by Van Huben’s Library Manager, it is provided by the creating ALM to the Library Manager.

Therefore, the citation provided by the Examiner does not teach or disclose “retrieving search information associated the data and tasks of the new resource” as claimed.

Regarding the Third Element of Claim 12

The Examiner rejected the third element of claim 12 “storing the first portion of the search information in a first manager data store” in which the Examiner provides only a citation to Col. 32, lines 9-45 of Van Huben and absolutely no discussion as to what in the citation provides the grounds for the rejection. The cited material is a high level discussion of configurations of Automated Library Machines and the relative benefits of each configuration with respect to load balancing, data throughput, etc. First, Applicants would like to point out that Col. 32, lines 9-45 are not related to a method of installing resources on a network. Second, Applicants submit that there is no mention of storing any information provided in response to the installation of a resource on the network. The citation does include a reference to Van Huben’s Control Repository, but Van Huben states that this Repository “contains the control information for all components of the design” and preferably is a database. Note here that Van Huben’s “design” is not a computer network or a network environment of any kind, therefore the Control Repository cannot be considered analogous to a data store storing information related to the data and tasks of the resources of the network. The citation provided simply does not disclose storing a first portion of information as claimed.

Regarding the Fourth Element of Claim 12

The Examiner rejected the fourth element of claim 12 “determining that a second portion of the search information relates to a second manager” in which the Examiner provides only a citation to Col. 35, lines 30-55 of Van Huben and absolutely no discussion as to what in the citation provides the grounds for the rejection.

First, Applicants’ would like to point out that the previous citations were all to a section of Van Huben that discussed “The Preferred Embodiment of Managed Shared Libraries” (see, Col. 30, lines 42-43) and that this citation is to a section in Van Huben that relates to the “File Promotion Process” that Van Huben describes as the “process for promoting data from a private library into a shared public library as well as moving data through a shared public library” (see, Col. 32, lines 59-63). As such, Applicants submit that the entire section of Van Huben is unrelated to the installation of a new resource to a network environment and do not anticipate the Applicants’ invention as claimed.

The citation provided by the Examiner discusses how “files” are treated when a user initiates a promote operation and, particularly, the use of a search utility to select files for promotion. Van Huben’s promotion scheme is very different from the claimed element for several reasons.

The claimed invention is limited to handling search information retrieved from a new resource in response to its installation on a network. This citation in Van Huben is related to the management of data files in a library scheme and is unrelated to the installation of a new resource. The files are neither new, or newly installed on the system – promotion is based on a user’s determination as to the completeness of the file.

Applicants’ agree that Van Huben’s system determines how to promote the “files” (although based at least in part on user input), but submit that this is not analogous to determining that a portion of the search information relates to a second manager. In Van Huben, each “file” is treated as a stand-alone element that is managed atomically and managed identically regardless of what resource it is stored on. Different portions of the “file” are never singled out as relating to a different resource. And in no case is a “file” split up and portions saved in different locations because of the nature of its contents. Van Huben’s system would not function if file integrity were not maintained.

The “files” in Van Huben do not contain information about data and tasks that may be performed by a new resource. Van Huben’s “files” are solely data files related to a design managed by the Design Control System.

Furthermore, Van Huben’s “files” were not retrieved as part of an installation process. The “files” are found in response to a user-initiated promotion request in which the network supporting the Design Control System is static.

Regarding the Fifth Element of Claim 12

The Examiner rejected the fifth element of claim 12 “storing the second portion of the search information in a second manager data store” in which the Examiner provides only a citation to Col. 39, lines 10-25 of Van Huben and absolutely no discussion as to what in the citation provides the grounds for the rejection. The citation provided discusses the overriding by a user of promotion processes. As discussed above, Van Huben’s promotion process is related to the movement and classification of data files and is unrelated to the installation of new resources on a network.

In the Examiner’s citation, a user can select and modify process parameters displayed in response to his promotion request query (see, Col. 39, lines 16-20). These processes all relate to how the file is to be classified with respect to the overall design. One important difference between Van Huben’s “files” and the claimed search information is that Van Huben’s files are always treated as complete units in that the files, regardless of how the user decides they are to be processed, are not divided up and portions saved in different locations.

Applicants’ claims, on the other hand, require that a first portion of the search information be stored in a first data store and that a second portion be stored in a second data store. Furthermore, Applicant’s search information is retrieved from the new resource, not provided by a user. Other differences between Applicant’s search information and Van Huben’s files are described above. For at least these reasons, this element of Applicants’ claimed invention is patentably distinguished from Van Huben.

Regarding Claim 13

The Examiner rejected an additional element of claim 13 “wherein the notification includes the search information” in which the Examiner provides only a citation to Col. 31, lines

18-38 of Van Huben and absolutely no discussion as to what in the citation provides the grounds for the rejection. While Applicants believe claim 12 is in allowable form and, thus, claim 13 is therefore allowable for the reasons described above, Applicants further traverse the Examiner's rejection of the element "wherein the notification includes the search information" in claim 13. In addition to the discussion of the differences between the Col. 31, lines 18-38 of Van Huben citation with respect to claim 12, Applicants' respectfully traverse the Examiner's rejection for additional reasons.

Van Huben's notifications as described in the citation are simple indicates of whether a task by the computer system has been successfully performed or not. First, Applicants' point out that the Examiner's citation is silent as to the contents of the notification beyond these generalisms. Second, Applicant's point out that the notifications described by Van Huben are unrelated to queries or searches, whether they be performed by a user or by the computing system. As such, Van Huben does not teach or disclose receiving a notification that includes search information as claimed in claim 13. For at least this reason, Applicants respectfully request that Claim 13 be allowed.

Regarding Claim 14

The Examiner rejected the three elements of claim 14 ("determining whether the search information relates to an existing object of the object type, the existing object including information from at least one second resource; if so, associating the search information with the existing object; and if not, associating the search information with a new object") in which the Examiner provides only a citation to Col. 35, line 1 to Col. 36, line 5 of Van Huben and absolutely no discussion as to what in the citation provides the grounds for the rejection. While Applicants believe claim 12 is in allowable form and, thus, claim 14 is therefore allowable for the reasons described above, Applicants further traverse the Examiner's rejection of the additional elements in claim 14. In addition to the discussion of the differences between the to Col. 35, line 1 to Col. 36, line 5 of Van Huben citation with respect to claim 12, Applicants' respectfully traverse the Examiner's rejection for additional reasons.

Applicants' claim 14 is basically an if-then-else statement regarding where to store the search information. In one case, the search information is stored in an existing object; in another, the search information is stored in a new object that is created, in response to the

installation of the resource, to hold the search information. The specification defines objects as being managed by a resource, but possibly containing information relating to many different resources.

The citation to Van Huben refers to the promotion process as previously described. This may be achieved by moving a “file” (or a related group of files) into a public library (a “Put”) or by moving the file “through a public library” (a “Promote”) (see, Col. 35, lines 58-60 “A Put refers to data entering a public library from a private library whereas a Promote refers to data moving through a public library.”). In both cases, the files are previously associated with a specific “design.” However, by “design” Van Huben means an engineering design, such as for example a computer chip design. Van Huben’s “design” is unrelated to and does not contain information regarding the computing environment upon which the Van Huben’s Design Control System itself is implemented.

Van Huben’s “files” are not search information as that term is defined in the specification. The files do not contain information regarding the data and tasks of a newly installed resource on the network.

Nor are Van Huben’s “designs” analogous to objects as that term is defined in the specification. Access to a “design” does not allow a user change anything other than the design and certainly does not allow the user to modify the network upon which the Design Control System is implemented.

Furthermore, the simple analogy between the two does not stand for other reasons. In Van Huben, a new design is not created when a file is put or promoted that is previously unassociated with a design (see, Col. 35, lines 38-39 “If any of these fields are invalid or missing, the user is prompted to enter the information.”).

Van Huben is Non-Analogous Art

An underlying theme to the arguments presented above is that Van Huben is non-analogous art. As set forth in § 2141.01(a) of the M.P.E.P.:

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re

Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060 - 61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem"); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

The Applicants' invention as claimed in claims 12-14 is directed to a method of installing a new resource into a network. Van Huben's invention is directed to a data management system tailored to managing data files associated with a complicated engineering design. While the language used may sound similar, the inventions are quite different and the problems addressed are unrelated. Therefore, Applicants believe that the rejection should be withdrawn and that the Examiner find the claims in an allowable form.

Conclusion

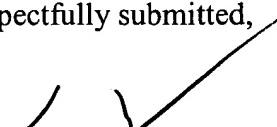
As a result of this amendment, claims 12-14 remain pending in this application. This amendment is believed to be fully responsive to all points in the Office Action. Pending claims 12-14 are believed to be in a condition for allowance. In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this Application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Dated:

6/28/04



Respectfully submitted,


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